

REMARKS

Claims 1-6, 15, 17 and 18 are rejected under 35 USC 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Claims 1-6, 15, 17 and 18 are rejected by the Examiner with a new matter rejection alleging they recite the limitation of "polynucleotides having at least 95% identity" and the specification does not disclose polynucleotides having at least 95% identity. Applicant respectfully submits that this is not new matter as the specification includes disclosure of several methods for making and using polynucleotide sequences and variants. The specification defines the term "identity" and provides methods and techniques for making and using polynucleotides of varying percent identities and for calculating percent identity (see pages 10-11). However, in an effort to expedite prosecution, these claims have been cancelled as required by the Examiner. New claims 19-32 do not include percent identity language. Applicant respectfully submits that the new claims are in a condition for allowance and requests that this rejection be withdrawn.

Claims 1-6, 11, 15, 17 and 18 remain rejected under 35 USC 101. The Examiner states that the specification teaches general utility for the invention, not a specific utility. Applicant vigorously disagrees. Provided herewith is a Declaration of Dr. Phillip Hemken which shows that the claimed marker CS194 is expressed 2.3 fold higher in colon tumor tissue pools when compared to normal colon tissue pools (see Figure 1 of Exhibit B). This upregulation of CS194 enables a clinician to test colon tissues taken from a patient and make a diagnosis between cancer and normal depending on the level of CS194 present in that sample. Thus, CS194 has utility for differentiating normal colon tissue from cancer colon tissue.

Claims 1-6, 11, 15, 17 and 18 remain rejected under 35 USC 112, first paragraph as containing subject matter which was not described in the specification in such a way as

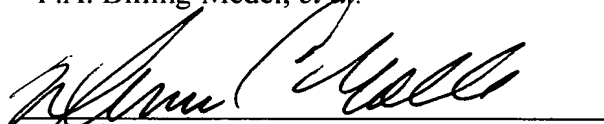
to enable one skilled in the art to make and/or use the invention. Moreover, Applicant asserts that in light of the above amendments and remarks, the new claims are in a condition for allowance and requests that this rejection be withdrawn.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claim reads "which codes for a protein". This claim has been cancelled. Applicant respectfully submits that the new claims are in a condition for allowance and requests that this rejection be withdrawn.

CONCLUSION

In view of the aforementioned amendments and remarks, Applicant respectfully submits that the above-referenced application is now in a condition for allowance and Applicant respectfully requests that the Examiner withdraw all outstanding objections and rejections and passes the application to allowance.

Respectfully submitted,
P.A. Billing-Medel, *et al.*


Mimi C. Goller
Registration No. 39,046
Attorney for Applicants

ABBOTT LABORATORIES
D-0377/AP6D-2
100 Abbott Park Road
Abbott Park, Illinois 60064-6050
Phone: (847) 935-7550
Fax: (847) 938-2623